

### REMARKS

Claims 23, 27, 35-47 and 50-51 are canceled without prejudice or disclaimer.

Claims 24 and 31 are amended to correct an inadvertently omitted "R" substituent in each structural formula. Support for this amendment is provided, for example, by the structures shown at page 14, line 1 of the application.

Claim 31 is amended to delete the phrase "peripheral circulation of said." Support for this amendment is provided, for example, in claim 24.

Claims 48 and 49 are amended to delete the term "pharmaceutical."

Claim 48 is amended to move the term "a physiologically acceptable carrier."

These amendments are made to make the claims more consistent and definite, and are not intended to limit the claimed invention in any way. Moreover, no new matter is added. The Examiner is requested to enter these amendments.

### **Telephone Interview**

Applicants thank the Examiner for helpful comments made during a telephone interview on October 11, 2005. In the interview, Applicants noted that a Request for Certificate of Correction would be filed in U.S. Patent No. 6,710,073. The Request was filed on October 21, 2005. A courtesy copy of the Certificate is enclosed herewith. Applicants can provide a copy of the Request and supporting documents if needed.

### **Information Disclosure Statement and References**

The Examiner stated that references listed in the Information Disclosure Statement submitted September 15, 2004 were not present in the parent application. Applicants herewith provide copies of the requested references. Also, Applicants note that the 1449 submitted September 15, 2004 contained an error in that citations AV and AW describe the same reference (Dyrks, et al., "Generation of  $\beta$ A4 from the amyloid protein precursor and fragments thereof, FEBS 13297, 335(1):89, 1993), except that the journal name in citation AV is incorrect. This error is corrected in the Substitute Information Disclosure Statement PTO Form 1449 supplied

herewith, and Applicants request the Examiner to acknowledge the references by initialing each citation therein.

### **Double patenting rejection under 35 U.S.C. § 101**

The Examiner rejects claims 23-36 [*sic*] under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-13 of U.S. Patent No. 6,710,073 B1 ("the '073 patent").

The standard for double patenting under 35 U.S.C. 101 is given in MPEP § 804 II.A:

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means **identical subject matter**. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957). (Emphasis added)

However, the present invention is not drawn to subject matter or are drawn to methods identical with that claimed by the '073 patent.

For example, independent claims 24 and 31 are method claims which comprise administering to a mammal a recited compound. By contrast, independent claims 2 and 9 in the '073 patent are drawn to methods which comprise administering a recited compound to the peripheral circulation of a mammal. Moreover, none of the present dependent claims is directed to subject matter identical to the claims of the '073 patent.

The statutory double patenting rejection of present claims 24-26, 28-34, and 36 is improper because these claims are not drawn to subject matter identical to that of the claims of the '073 patent. Also, the rejection of claims 23, 27, 35, and 36 is mooted by their cancellation. Applicants respectfully request the rejection under 35 U.S.C. § 101 be withdrawn.

### **Obviousness type double patenting rejection**

The Examiner rejects claims 48 and 49 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claim 1 of the '073 patent. Applicants enclose herewith a terminal disclaimer under 37 C.F.R. § 1.321 (b), and request that the obviousness-type double patenting rejection be withdrawn.

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Filed : March 22, 2004  
Page : 9 of 9

Attorney's Docket No.: 07306-003003 / UC 1991-169-3

### Rejection under 35 U.S.C. § 112, second paragraph

The Examiner states that the claims are self-conflicting because they are drawn to pharmaceutical compositions without a dosage limitation. Applicants have deleted the term "pharmaceutical" from claims 48 and 49. Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

### Conclusion

For the reasons set forth above, Applicants submit that the claims of this application are patentable. Reconsideration and withdrawal of the Examiner's objections and rejections are hereby requested. Allowance of the claims remaining in this application is earnestly solicited.


In the event that a telephone conversation could expedite the prosecution of this application, the Examiner is requested to call the undersigned at (650) 839-5078.

Enclosed is a check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date:

October 24, 2005

  
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